REMARKS

1. In response to the Introduction, Applicant acknowledges that claims 1-28 are pending, but believes no further remarks are necessary.

2. In response to the Response to Amendment, Applicant acknowledges and appreciates the Office's withdrawal of the § 101 rejections as to claims 15-20.

3. The Office rejects claims 1-14 under 35 U.S.C. § 101 as being directed to non-statutory subject matter because they "describe a process without an obvious tie to another statutory class", *i.e.*, "a claimed process must" be "tied to a particular machine or apparatus" or "transforms a particular article to a different state or thing." Amended, independent claims 1 and 10, which collectively encompass dependent claims 2-9 and 11-14, are now tied to a machine, *i.e.* "a processing device having an interactive interface", as found in the original specification, wherein this processing device and its interface have bedrock fundamentality for the claimed invention. Furthermore, the claimed processing device is also in communication with another machine or apparatus, namely a claimed database. Accordingly, Applicant respectfully requests withdrawal of the § 101 rejections directed at claims 1-14.

4. The Office rejects claims 1-3 under 35 U.S.C. § 102(b) as being anticipated by Guinta, *et al.*, U.S. Patent No. 5,737,494 ("Guinta"). Applicant objects with traverse to Guinta anticipating Applicant's claims 1-3.

   For a claim to be anticipated, Guinta must describe each element and limitation of that claim.[1] Furthermore, such description must "enable one of skill in the art to make and use the claimed invention".[2] Below, Applicant shows that Applicant's claims 1-3 are not enablingly anticipated by Guinta as a matter of law.

---

[1] *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1349 (Fed. Cir. 1998); *Celeritas Techs. Ltd. v. Rockwell Intl. Corp.*, 150 F.3d 1354, 1360 (Fed. Cir. 1998).

[2] *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1374 (Fed. Cir. 2001)(quoting *In re Donohue*, 766 F.2d 531, 533 (Fed. Cir. 1985).

Amended claim 1 states: A method for improving an audit within a controlled environment, the method comprising:

determining, on a portable processing device having an interactive interface, a quality issue to address, the quality issue being associated with a product, wherein the product is the subject of the audit;

selecting, on the portable processing device, a group of questions associated with the quality issue;

posing, on the interactive interface, a question of the group of questions to gather information related to evaluation of the quality issue, wherein the portable processing device is adapted for operation within the controlled environment consisting of a clean room;

determining, on the portable processing device having the interactive interface, a sub-group of the group of questions, the sub-group being selected based upon an association with the information received in response to the question; and

storing, on a database in communication with the portable processing device, the information.

First, Guinta does not describe Applicant's "portable processing device". Accordingly, Guinta does not anticipate Applicant's claims.

Second, contrary to the Office, Guinta fails to describe Applicant's third claim element and its limitations. Specifically, Guinta does not describe "the portable processing device is adapted for operation within the controlled environment consisting of a clean room." For example, see Guinta's Figure 4. Here, the portable processing device's ability to be used within a clean room is a functional requirement of the portable processing device, itself. As stated at the specification's paragraph 42:

> Controlled environment 170 may be a facility of a fabricator, upon which the fabricator places restrictions on materials that may enter, e.g., to preserve the integrity of equipment, processes, maintenance procedures, . . . 172 within the controlled environment 170 as well as the resulting product(s) prepared by the fabricator. For instance, a semiconductor fabricator must monitor and filter out

> the particulates in the air of a clean room in which semiconductors are processed because the scale of the circuits that are being created is comparable to dust particles normally in the air. Many such fabricators will not allow paper, or at least paper from outside the facility, to enter into their clean rooms because the particulates that may be given off of paper could potentially destroy integrated circuits being manufactured in the clean rooms. *See also*, paragraphs 6-8.

Thus, since Applicant's claim language of "the portable processing device is adapted for operation within the controlled environment consisting of a clean room" covers what its invention is, and not what it does, then Guinta's complete failure to describe, much less with the required enablement, this salient limitation renders non-anticipation of Applicant's claims.[3]

Third, and reading the claims as a whole as required[4], Guinta does not describe Applicant's "determining a quality issue", much less the "the quality issue being associated with a product", and "wherein the product is the subject of the audit." Furthermore, Guinta fails to describe the same with the required enablement. Instead, Guinta, at best, describes "assess[ing] characteristics of the supplier," wherein "characteristics" are "numerical values." *See, e.g.*, Guinta's claims 2 and 3. Guinta "prompts an assessor" "to numerically input the assessor's perception of the capability of the organizational process or system to address an issue." Guinta, col. 2, ll. 43-46. In further support, even the Office admits that Guinta describes a system, *not* a product like Applicant claims. Accordingly, Guinta does not provide an enabling description or teaching of the foregoing, claimed limitations.

Finally, the Office again admits on page 14 of the Office Action that Guinta "*does not explicitly disclose that the sub-group questions are relevant to a quality issue.*" Applicant agrees and this means that Guinta does not describe or teach Applicant's first or second elements' limitations of "a quality issue … associated with a product" and "group of

---

[3] *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469 (Fed. Cir. 1990); *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1349 (Fed. Cir. 1998); *Celeritas Techs. Ltd. v. Rockwell Intl. Corp.*, 150 F.3d 1354, 1360 (Fed. Cir. 1998).

[4] *Q-Pharma, Inc. v. Andrew Jergens Co.*, 360 F.3d 1295 (Fed. Cir. 2004) (What is claimed is defined by the claim taken as a whole, and every limitation in a claim is material.)

questions associated with the quality issue", respectively, which is necessarily tied to Applicant's fourth element's limitation regarding "sub-group of the group of questions." In sum, Guinta also fails to describe Applicant's first, second, and fourth element and their respective limitations.

Based on any of the foregoing reasons, Guinta's failure to describe each and every element and limitation of Applicant's claim 1 means Guinta anticipates neither Applicant's claim 1 nor its dependent claims 2 and 3.[5] Applicant agrees with the Office's non-contention that Guinta, even in view of any of the cited art, does not render obvious Applicant's claim 1, and, based thereon, then none of its dependent claims 4-9 are not rendered obvious by Guinta.

Notably, Prather does not cure the above-cited missing descriptions and failed teachings of Guinta, wherein all of which are common to all of Applicant's claims. For example, Applicant agrees with the Office that Guinta "does not explicitly disclose interacting with a user to select the quality issue" and "does not explicitly disclose selecting a quality issue based upon a product." Specifically, Prather does not mention anything regarding "a quality issue" or "a quality issue based upon a product." Since Guinta and Prather fail to provide enabling descriptions and teachings for all elements and limitations as previously shown in contravention of the Office's allegations, the same do not support obviousness rejections of claims 4-28.[6] Therefore, Applicant respectfully requests withdrawal of both the anticipation rejections of claims 1-3 and obviousness rejections of claims 4-28 as a matter of law based on Guinta's and Prather's missing descriptions and failed teachings of all of Applicant's claims' elements and limitations.

---

[5] *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1349 (Fed. Cir. 1998); *Celeritas Techs. Ltd. v. Rockwell Intl. Corp.*, 150 F.3d 1354, 1360 (Fed. Cir. 1998); *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988)(if independent claim is allowable, then so are the dependent claims).

[6] *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988)(if independent claim is allowable, then so are the dependent claims); MPEP § 2142; *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991); *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986); *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974); *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1374 (Fed. Cir. 2001)(quoting *In re Donohue*, 766 F.2d 531, 533 (Fed. Cir. 1985) (enabling disclosure required).

CONCLUSION

Based on the foregoing, Applicant respectfully submits that the application is in condition for allowance. Applicant invites the Office to freely reach Applicant's attorney at the contact information found in the signature block below.

No fee is believed due with this paper. However, if any fee is determined to be required, the Office is authorized to charge Deposit Account 09-0447 for any such required fee.

Respectfully submitted,

Date: December 4, 2009

/Erik J. Osterrieder/
Erik J. Osterrieder
Reg. No. 48,966
Schubert Osterrieder & Nickelson PLLC
6013 Cannon Mtn. Dr., S14
Austin, TX 78749
Tel: (713) 533-0494
Fax: (512) 301-7301
E-mail: ejo@sonlaw.com
ATTORNEY FOR APPLICANT/ASSIGNEE